



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,188	03/19/2001	Tomoshi Hirayama	204947US6	6951
22850	7590	10/04/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			BRUCKART, BENJAMIN R	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/810,188

Applicant(s)

HIRAYAMA, TOMOSHI

Examiner

Benjamin R. Bruckart

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,11 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,11 and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **Detailed Action**

#### **Status of Claims:**

Claims 1, 3-5, 11, 30-34 are pending in this Office Action.

Claims 2, 6-10, 12-29 are cancelled.

Claims 30-34 are new.

Claim 4 is amended.

### **Response to Arguments**

Applicant's arguments filed in the amendment filed 1/18/05, have been fully considered but they are not persuasive. The reasons are set forth below.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-5, 30-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending

Application No. 09/811,516. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Instant Application 09/810,188	Co-pending Related App 09/811,516	Comments
Claim 4 Acquisition Validity Condition Associating information Transmitting	Claim 1, 6, 7 Acquisition through input Validity Judgement Assignment Means Output Means	Acquisition means in both claims dealing with same objects and identifier information. Validity Judging and conditions serve the same purpose.
Claims 1 and 11	Claim 2	Disseminated by broadcasting
Claim 5	Claims 3 and 5	Additional information
Claim 1, 4, and 11	Claim 4	Content transmitting based on the request

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-5, 30-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 contains an information processing apparatus connected by a network to a first information processing apparatus comprising acquisition, generating, storage, transmission means for processing information. There is no hardware embodiment in the claim language and the invention may be embodied in software only. No tangibly embodied mediums are cited. Similarly for independent claims 4, which includes validity conditions, and 11, which includes an extraction, which dependent claims 3, 5, 30-34 rely on.

**Applicant's invention as claimed:**

**Claim 1, 3, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,331,865 by Sachs et al in view of U.S. Patent No 6,686,880 by Marko et al.**

Regarding claim 1,

an information processing apparatus connected by a network to a first information processing apparatus for presenting a content (Sachs: col. 2, lines 44-46; Fig. 1) comprising:

an acquisition means for acquiring information on said first information processing apparatus (Sachs: col. 4, lines 47-50; col. 5, line 49-58; URL) and information on a content presented by said first information processing apparatus from said first information processing apparatus (Sachs: col. 4, lines 47-50; col. 5, line 49-58; content key);

a generation means for generating information processing apparatus identification information for identifying said first information processing apparatus (Sachs: col. 4, lines 30-33; secret session key) and generating content identification information for identifying a content on the basis of said information on said first information processing apparatus and said information on a content (Sachs: col. 4, lines 51-57; digital envelope), which are acquired by said acquisition means;

a storage means for storing said information processing apparatus identification information and said content identification information (Sachs: col. 3, line 63- col. 4, line 7; col. 4, lines 58-65), which are generated by said generation means, by associating said information processing apparatus identification information with said content identification information (Sachs: col. 4, lines 58-65); and

a transmission means for transmitting information on association stored in said storage means to a second information processing apparatus in response to a request made by said second information processing apparatus through said network (Sachs: col. 4, lines 58-67);

said storage means further stores said identification information (transmission identification information) by associating said identification information (transmission identification information) with said information processing apparatus identification information and said content identification information (Sachs: col. 4, line 55, 51-63).

The Sachs reference does not explicitly state broadcasting.

The Marko reference teaches information disseminated by broadcasting, acquiring broadcasting identification information (transmission identification information) assigned to said broadcasting (Marko: col. 4, lines 61- col. 5, line 13); and

said storage means further stores said broadcasting identification information (transmission identification information) by associating said broadcasting identification information (transmission identification information) with said information processing apparatus identification information and said content identification information (Marko: col. 5, lines 10-13).

The Marko reference further teaches the invention utilizes a system controller to format message with an ID for a cost effective broadcast transmission (Marko: col. 6, lines 17-36).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the information processing apparatus as taught by Sachs while employing broadcasting as taught by Marko in order to utilize cost effective broadcasts with Identifiers.

Claim 3 is rejected under the same rationale given above. In the rejections set forth, the examiner will address the additional limitations and point to the relevant teachings of Marko and Sachs.

Regarding claim 3, an information processing apparatus according to claim 1, wherein said storage means further stores the address of said first information processing apparatus in said network (Sachs: col. 4, lines 47-50; col. 5, line 49-58; URL); and

said apparatus further comprises an access controlling means for controlling accesses made to said first information processing apparatus through said network on the basis of any one of said information processing apparatus identification information, said content identification information and said broadcasting identification information (transmission identification information), which have been acquired from a third information processing apparatus (Sachs: col. 3, lines 63- col. 4, line 8).

Regarding claim 11,

an information processing apparatus (Sachs: Fig. 1), comprising:

an extraction means for extracting content identification information for identifying a content presented by a first information processing apparatus (Sachs: col. 4, lines 47-50; col. 5, line 49-58; URL) and first information processing apparatus identification information for identifying said first information processing apparatus from a received signal (Sachs: col. 4, lines 47-50; col. 5, line 49-58; content key);

a storage means for storing second information processing apparatus identification information for identifying said information processing apparatus itself (Sachs: col. 4, line 51-57); and

a request means for transmitting said content identification information and said first information processing apparatus identification information (Sachs: col. 4, lines 51-67), which are extracted by said extraction means, along with said second information processing apparatus identification information stored in said storage means to a second information processing apparatus so as to request said first information processing apparatus to present a content identified by said content identification information (Sachs: col. 4, lines 51-67);

said storage means further stores said identification information (transmission identification information) by associating said identification information (transmission identification information) with said first information processing apparatus identification information and said content identification information (Sachs: col. 4, line 55, lines 51-67).

The Sachs reference does not explicitly state broadcasting.

The Marko reference teaches information disseminated by broadcasting, said extraction means further extracts broadcasting identification information (transmission identification information) assigned to said broadcasting (Marko: col. 4, lines 61- col. 5, line 13); and

said storage means further stores said broadcasting identification information (transmission identification information) by associating said broadcasting identification information (transmission identification information) with said first information processing apparatus identification information and said content identification information (Marko: col. 5, lines 10-13).

The Marko reference further teaches the invention utilizes a system controller to format message with an ID for a cost effective broadcast transmission (Marko: col. 6, lines 17-36).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the information processing apparatus as taught by Sachs while employing broadcasting as taught by Marko in order to utilize cost effective broadcasts with identifiers.

**Claim 4-5, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,331,865 by Sachs et al in view of U.S. Patent No. 5,634,012 by Stefick et al.**

Regarding claim 4, an information processing apparatus connected by a network to a first information processing apparatus for presenting a content (Sachs: col. 2, lines 44-46; Fig. 1) comprising:

an acquisition means for acquiring information on said first information processing apparatus (Sachs: col. 4, lines 47-50; col. 5, line 49-58; URL) and information on a content presented by said first information processing apparatus from said first information processing apparatus (Sachs: col. 4, lines 47-50; col. 5, line 49-58; content key);

a generation means for generating information processing apparatus identification information for identifying said first information processing apparatus (Sachs: col. 4, lines 30-33; secret session key) and generating content identification information for identifying a content on the basis of said information on said first information processing apparatus and said information on a content (Sachs: col. 4, lines 51-57; digital envelope), which are acquired by said acquisition means;

a storage means for storing said information processing apparatus identification information and said content identification information (Sachs: col. 3, line 63- col. 4, line 7; col. 4, lines 58-65), which are generated by said generation means, by associating said information processing apparatus identification information with said content identification information (Sachs: col. 4, lines 58-65); and

a transmission means for transmitting information on association stored in said storage means to a second information processing apparatus in response to a request made by said second information processing apparatus through said network (Sachs: col. 4, lines 58-67).

The Sachs reference does not explicitly state a validity-condition.

The Stefick reference teaches

wherein acquisition means further acquiring a validity-condition concerning validity of presentation of a content from said first information processing apparatus (Stefick: col. 7, lines 26-30); and

said storage means further stores said validity-condition by associating said validity-condition with said information processing apparatus identification information and said content identification information (Stefick: col. 9, lines 62- col. 10, line 7), wherein

said acquisition means further acquires a validity-condition concerning validity of a content from said first information processing apparatus (Stefick: col. 7, lines 26-30); and

said storage means further stores said validity-condition by associating said validity-condition with said information processing apparatus identification information and said content identification information (Stefick: col. 9, lines 62- col. 10, line 7).

Art Unit: 2155

The Stefick reference further teaches the invention allows control of content to prevent unauthorized distribution (Stefick: col. 1, lines 60-65).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the information processing apparatus as taught by Sachs while employing validity conditions as taught by Stefick in order to control content distribution to prevent unauthorized distribution (Stefick: col. 1, lines 60-65).

Claims 5, 30 are rejected under the same rationale given above. In the rejections set fourth, the examiner will address the additional limitations and point to the relevant teachings of Stefick and Sachs.

Regarding claim 5, an information processing apparatus according to claim 4, wherein said validity-condition includes information on additional information added by a user receiving data including said information processing apparatus identification information and said content identification information (Sachs: col. 3, lines 31-45).

Regarding claim 30, the information processing apparatus of claim 4, wherein said validity-condition is a deadline for accepting a response (Stefick: col. 2, lines 1-3; col. 10, lines 54-56, 58-60).

**Claim 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,331,865 by Sachs et al in view of U.S. Patent No. 5,634,012 by Stefick et al in further view of U.S. Patent No 6,704,787 by Umbreit.**

Regarding claim 31,

The Sachs and Stefick references teach the information processing apparatus of claim 4.

The Sachs and Stefick references do not explicitly state an age restriction.

The Umbreit reference teaches a validity-condition is an age restriction (Umbreit: col. 2, lines 29; col. 3, lines 10-29).

The Umbreit reference further teaches the invention restrictions discussions and information to only certain persons or groups of people (Umbreit: col. 1, lines 64-67).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the information processing apparatus as taught by Sachs and Stefick while employing age restrictions as taught by Umbreit in order to restrict discussions and information to only certain persons or groups of people (Umbreit: col. 1, lines 64-67).

Claims 32-34 are rejected under the same rationale given above. In the rejections set fourth, the examiner will address the additional limitations and point to the relevant teachings of Umbreit, Stefick and Sachs.

Regarding claim 32, the information processing apparatus of claim 4, wherein said validation condition is an adult category (Umbreit: col. 5, lines 40-59).

Regarding claim 33, the information processing apparatus of claim 4, wherein said validity condition is a registered person (Sachs: col. 3, lines 54- col. 4, line 11; Umbreit: col. 2, lines 14-



Art Unit: 2155

23).

Regarding claim 34, the information processing apparatus of claim 4, wherein said validation condition is an area restriction (Umbreit: col. 2, lines 21-35).

### **REMARKS**

Applicant amended claim 4 and added claims 30-34. The claim language is still very broad. General terminology such as the constant reference to "information" in the claim language allows much prior art to read openly on the claims.

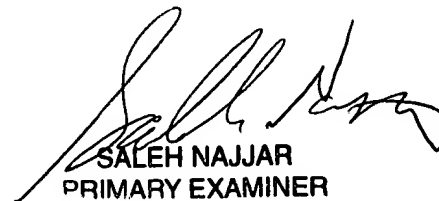
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R. Bruckart whose telephone number is (571) 272-3982. The examiner can normally be reached on 8:00-5:30PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin R Bruckart  
Examiner  
Art Unit 2155



SALEH NAJJAR  
PRIMARY EXAMINER